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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,223	12/12/2005	Haruhiko Ikeda	36856.1394	2555
54066 7590 06/24/2008 MURATA MANUFACTURING COMPANY, LTD. C/O KEATING & BENNETT, LLP 8180 GREENSBORO DRIVE SUITE 850 MCLEAN, VA 22102				
EXAMINER GREEN, PHILLIP				
ART UNIT 2823		PAPER NUMBER		
NOTIFICATION DATE 06/24/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

## Application No.

10/560,223

## Applicant(s)

IKEDA, HARUHIKO

## Examiner

PHILLIP GREEN

## Art Unit

2823

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2/14/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 8-13 are objected to because of the following informalities: Claims 8-13 recites the limitation "the step". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatani et al (US 6625037) and Sugaya et al (US 6931725) in further view of Sugaya et al (US 20050186768 A1).

Re claim 8, Sugaya discloses a process for producing a component-embedded substrate, comprising the steps of:

connecting and fixing a first electronic component (304) to a first electrode (303) pattern on a first supporting layer (305) with a conductive bonding material;  
press-bonding a second supporting layer (307) including a second electrode pattern (306) onto the electronic component-fixed surface of the first supporting layer (305) with a first prepreg therebetween to perform transfer; (Note: Figure 3F)

separating the first supporting layer (305) and the second supporting layer (307) from the first prepreg such that the first and second electrode patterns (304 and 306) are disposed on a front surface and a back surface of the first prepreg; (Note: Figure 3I)

curing the first prepreg before or after the step of separating the first supporting layer and the second supporting layer from the first prepreg; (Note: Column 17, 1-16)

Although Sugaya discloses a second electronic component, Sugaya does not explicitly disclose the manner used to attach the electronic component.

Nakatani discloses a method of producing a component-embedded substrate. Nakatani connects and fixes a first electronic component to a first electrode pattern on a first supporting layer with a conductive bonding material; press-bonding a resin layer onto the electronic component-fixed surface of the first supporting layer;

connecting and fixing a second electronic component onto a back surface of the second electrode pattern with a conductive bonding material.;

press-bonding a third supporting layer including a third electrode pattern onto a second electronic component-fixed surface with a second prepreg therebetween to perform transfer;

separating the third supporting layer from the second prepreg; and curing the second prepreg before or after the step of separating the third supporting layer from the second prepreg, wherein the prepregs and the electrode patterns are sequentially laminated. (Note: Figure 6).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant(s) claimed invention was made to provide Sugaya et al. reference

Art Unit: 2823

with the second component attached, pressed and heated as taught by the Nakatani et al. in order to allow "the epoxy resin in the sheet to be cured, so that the circuit components and the wiring pattern and the sheet were strongly connected mechanically." (Note: Column 20, line 38-57).

Nakatani and the Sugaya patent do not explicitly disclose the curing step of the present application.

The Sugaya pre-grant publication teaches a transfer material capable of transferring a fine wiring pattern to a substrate reliably and easily. The transfer material includes at least three layers of a first metal layer as a carrier, a second metal layer that is transferred to the substrate as a wiring pattern, and a peel layer adhering the first and second metal layers releasably. On the surface portion of the first metal layer, a concave and convex portion corresponding to the wiring pattern is formed, and the peel layer and the second metal layer are formed on a region of the convex portions. Sugaya teaches a curing method and discloses the individual curing method as widely known in art. (Note: Paragraph 0137)

It would have been obvious to combine the teachings of Nakatani and Sugaya to enable the disclosed pattern transfer to be cured according to the teachings of Sugaya. One of ordinary skill in the art would have had a reasonable expectation of success that the curing of Sugaya would have produced a working device in view of the disclosure that the curing method is widely known in the art. Also, one of ordinary skill in the art would have been led to the recited curing to achieve the desired pattern transfer on the finished substrate.

Ex parte Rubin , 128 USPQ 440 (Bd. App. 1959) (Prior art reference disclosing a process of making a laminated sheet wherein a base sheet is first coated with a metallic film and thereafter impregnated with a thermosetting material was held to render prima facie obvious claims directed to a process of making a laminated sheet by reversing the order of the prior art process steps.). See also In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is prima facie obvious in the absence of new or unexpected results); In re Gibson, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is prima facie obvious.).

Re claim 9, as applied to claim 8 in the paragraph above, Nakatani and Sugaya disclose the claimed limitations, including,

forming a through hole in the first prepreg which extends in a thickness direction of the first prepreg after heating the prepreg; and

forming a conducting path inside the through hole, the conducting path electrically connecting the first and second electrode patterns provided on the front surface and the back surface of the first prepreg. (Note: Nakatani, Column 8, line 45 – Column 9, line 62, where Nakatani teaches a temporary curing).

Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ

Art Unit: 2823

233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.)

Re claim 10, as applied to claim 8 in the paragraph above, Nakatani and Sugaya disclose the claimed limitations, including,

forming a through hole in the first prepreg connecting the electrode pattern provided on the front surface or the back surface of the first prepreg with an external electrode of the first electronic component after heating the first prepreg; and

forming the conducting path inside the through hole, the conducting path electrically connecting the electrode pattern with the external electrode of the first or second electronic component. (Note: Nakatani, Column 8, line 45 – Column 9, line 62 and Figure 6)

Re claim 11, as applied to claim 8 in the paragraph above, Nakatani and Sugaya disclose the claimed limitations, including,

wherein the step of curing the first prepreg further comprises the substeps of: performing temporary curing before separating the first and second supporting layers from the first prepreg; and

performing complete curing after separating the first and second supporting layers from the first prepreg. (Note Sugaya, Figure 3; Nakatani, Column 8, line 45 – Column 9, line 62)

Re claim 12, as applied to claim 8 in the paragraph above, Nakatani and Sugaya disclose the claimed limitations, including,

wherein the step of curing the second prepreg further comprises the substeps of: performing temporary curing before separating the third supporting layer from the second prepreg; and

performing complete curing after separating the third supporting layer from the second prepreg. (Note Nakatani, Figure 6)

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 8-12 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

5. **THIS ACTION IS MADE NON-FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

#### ***Correspondence***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHILLIP GREEN whose telephone number is (571)272-7024. The examiner can normally be reached on Monday - Thursday; 9 a.m - 7 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on (571)272-1907. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2823

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brook Kebede/

Primary Examiner, Art Unit 2823

/P. G./

Examiner, Art Unit 2823

05/17/2008